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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/710,740

07/30/2004

Henry TSUEI

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24728

7590

06/29/2006

MORRIS MANNING & MARTIN LLP
1600 ATLANTA FINANCIAL CENTER
3343 PEACHTREE ROAD, NE
ATLANTA, GA 30326-1044

EXAMINER

LE, THIEN MINH

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	10/710,740	TSUEI ET AL.	
	Examiner	Art Unit	
	Thien M. Le	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 36 and 44-48 is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 9, 15, 18, 20, 22, 24-33, 35 and 37-43 is/are rejected.
- 7) ☒ Claim(s) 5-6, 8, 10-14, 16-17, 19, 21, 23, 34 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 recites the limitation "the bin number" in line 1. There is insufficient antecedent basis for this limitation in the claim. The proper support for "the bin number" is found in claim 6 rather than claim 1.

Similarly, claim 18 lacks the proper antecedent basis for the limitation "the bin number" as recited in line 1. Correct support for this limitation is found in claim 17.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4, 9, 15, 20, 24-33, 35, and 37-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Cook et al. (Cook et al. – 6,675,153; herein after referred to as Cook).

Regarding claims 1, 9, 15, 20, and 39-43, Cook discloses a “method and apparatus for authorizing a transaction between a consumer and a merchant over a network where the anonymity of the consumer with respect to the merchant is maintained while still validating the authenticity of the consumer prior to completing the transaction” (see the abstract). The system includes a central processing/database (figure 1; Zixcharge secure data center 102 – also see descriptions in the specification) for maintaining true name, true address, true account number, and alias name, alias address, and alias account number (see the descriptions of figure 1). According to Cook, aliases such as alias address, alias account, and alias name can be used for conducting transaction without revealing real personal information on the Internet, Websites, and/or even merchants for security and privacy purposes. The Zixcharge system is trusted with matching aliases with real information, sending request to card issuer for credit card transaction approval, providing the true customer's address for delivery purposes, etc. (see figures

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1-5 and their descriptions; also see claims 3,5-8,35-36, 45-47 and 53-55). As can be seen, Cook discloses the claimed invention.

Regarding claim 2, see the discussions regarding claim 1 (also see col. 5, lines 40-68; claims 3, 5, 6, 8, etc.). Accordingly, the discussions of the alias address by Cook would embrace all limitations set forth in this claim.

Regarding claim 3, see the discussions regarding claims 1-2. Further, since the system is designed to protect customer's personal information such that he/she remains anonymous while conducting a valid transaction with a merchant, the examiner is of the view that payment and address aliases would include an alias of the customer's name and thus would embrace all limitations set forth in this claim.

Regarding claim 4, see the discussions above regarding claims 1-3. Accordingly the step of mailing the merchandise to a customer includes the step of re-labeling the merchandise with true name and true addresses.

Regarding claims 24-29 and 37-38, see the discussions regarding claim 1. The examiner is considering the alias address as the unique personal mail code; the step of correlating the alias address with the true/real physical address is considered as the claimed mapping step; the step of receiving and/or sending real shipping address to the shipper as the necessary functions of the Zixcharge Secure Data Center 102.

Regarding claim 30, see the discussions above. Further, Cook discloses the method and steps for registering the customer's name, credit card, and other financial or personal information with the Zixcharge's system.

Regarding claim 31, see the discussions above regarding claim 1.

Regarding claim 32, see the discussions above regarding claim 1.

Regarding claim 33, see the discussions above and the descriptions of the Zixcharge's member ID in the specification.

Regarding claim 35, see the discussion above. Cook discloses the various security techniques to protect customer's information using registration, membership ID, encryption techniques, etc., that would embrace all limitation set forth in this claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. (Cook et al. – 6,675,153; herein after referred to as Cook).

Regarding claim 22, see the discussions regarding claim 20. The claim differs in calling for a wireless communication link between the shipper and the central server, in this case the Zixcharge Secure Data Center 102. It would have been obvious to replace the communication link between the Zixcharge Data Center 102 and the shipper with a wireless communication link. The modification is merely a substitution of one type of communication link with another; and it considered to be well within the skill levels and expectations of an ordinary skilled artisan.

Allowable Subject Matter

Claim 36, and 44-48 are allowed.

Claims 5-6, 8, 10-14, 16-17, 19, 21, 23, 34 dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art discloses the system and method for protecting customer's personal information while conducting transactions with merchants, vendors, and others. However, the prior art fails to disclose such a system with the specifics including: (i) sending request to/from server to an off-line database as recited in claims 5 and 12; (ii) alias includes a bin number as recited in claims 6, 13, and 17; (iii) the step automatically scanned into a relabeling system as recited in claims 8, 14, and 19; (iv) the step of relabeling merchandize while it is in transit as recited in claims 10, 21, and 23; (vi) the method step for generating second unique personal code, the step of mapping the second unique personal code, etc., as recited in claims 34 and 36 ; (vii) the steps of correlating the aliases with the first and the second primary accounts as recited in claims 44-48.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (571) 272-2396. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Le, Thien Minh
Primary Examiner
Art Unit 2876
June 22, 2006